



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,095	11/22/2000	Aaron I. Vinik	05216.00001	5818

22907 7590 10/21/2003  
BANNER & WITCOFF  
1001 G STREET N W  
SUITE 1100  
WASHINGTON, DC 20001

EXAMINER

ROBINSON, HOPE A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 10/21/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

# **Interview Summary**

**Application No.**

09/717,095

**Applicant(s)**

VINIK ET AL.

**Examiner**Karen Cochrane Carlson,  
Ph.D.**Art Unit**

1653

All participants (applicant, applicant's representative, PTO personnel):

(1) Karen Cochrane Carlson, Ph.D.

(3) \_\_\_\_\_

(2) Sarah Kagan.

(4) \_\_\_\_\_

Date of Interview: 20 October 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference

c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: \_\_\_\_\_

Claim(s) discussed: pending.

Identification of prior art discussed: n/a.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

  
KAREN COCHRANE CARLSON, PH.D.  
PRIMARY EXAMINER

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

\_\_\_\_\_  
Examiner's signature, if required

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The terminal disclaimer filed in this application was found to be improper because the applications are not commonly owned. Ms Kagan called to discuss the ODP between SN 09/717095 and 09/659379. KCC explained that the claims as written comprise limitations that are the same, thus, the ODP is the correct provisional rejection. SK voiced concern that the standards of obviousness have not been met, and that her arguments of non-obvious have not been addressed. KCC and SK discussed possible non-obviousness between the application claims and did not reach agreement per se. KCC did discuss redrafting the claims to avoid the ODP altogether. After the interview, KCC faxed the attached comments regarding potential claims that could be drafted in each application to avoid ODP..

Art Unit: 1653

Sarah,

Please take a look at the diagrams below. I think that you can get around the ODP if the claims are drafted to focus on the differences and get away from the sameness.

Karen Carlson

09/659379

Met-Met-~~signal~~ 26-27 mature 175 NO : 6

09/717095

Met 174 NO : 2

In '379, the DNA could be claimed :

An isolated nucleic acid molecule comprising nucleotides encoding SEQ ID NO: 6.

The additional Met would not be obvious. But, if you use comprising language in '095, then there would be ODP because that DNA could include the Met.

An isolated nucleic acid molecule consisting of nucleotides encoding amino acid residues 27 to 175 of SEQ ID NO: 6.

In '095, the DNA could be claimed:

An isolated nucleic acid molecule consisting of nucleotides encoding SEQ ID NO: 2.

Art Unit: 1653

Sarah, you could still do vectors (hosts, methods of making, etc) with "consisting of" language for the nucleotides encoding protein, just make sure that there is heterologous nucleotides around the sequence.

An expression vector comprising a nucleotide sequence consisting of nucleotides encoding....

If you claim portions and probes, then do it in only one of the applications.